

## **REMARKS**

Claims 33-62 are now pending in the application. Claims 33, 39, 49, 54, 55, and 59 are currently amended. No additional claims are cancelled. Claims 33a, 39a, and 49a are new. Support for the foregoing amendment can be found throughout the specification, drawings, and claims as originally filed. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

## **REJECTION UNDER 35 U.S.C. § 103**

Claims 33-62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kanebo LTD (JP Pat. App. No. 06-030911) (“Kanebo”) in view of Trademark/Service Mark Application, Principal Register, with Declaration, eTEAS-Version 1.2a (“TEAS”). This rejection is respectfully traversed.

Amended claim 33 is distinguished by the feature of: “Means for selecting individual goods/services from a predetermined list presented to a user, where the selection is in response to an input by the user.” Basis for the amended feature is found in the specification as published at [0141] and as shown in Figures 11-15 and the text corresponding thereto.

Amended claims 39, 49, 54, 55, and 59 include the feature that an electronic commerce system presents an online user with a predetermined list of goods/services. In the specification as published, the online nature of the system is described, for example, at [0129] and generally as well.

Paragraph numbers throughout the remainder of these remarks correspond to the appropriate paragraph numbers in the present Office action.

### **Kanebo**

3. Kanebo Limited discloses a system for preparing an application to register a trademark. The disclosure of Kanebo recognizes in the prior art that the relationship between different goods and services and a business is complicated, and written mistakes occurred frequently at [0002]. Kanebo reiterates, back in 1995, the problems incurred with trademark applications, in particular inefficiency [0002], and that written mistakes frequently occurred in lists of specified goods in trademarks.

The problem to be solved by the Kanebo invention is how to automatically print list of goods [0040]. The invention in Kanebo does not appear to be aimed at solving the problems with on-line filing. There is no disclosure of on-line filing by way of an e-commerce solution. Rather, the disclosure in Kanebo is a paper based solution, effected by printing out a list of goods and services to be sent for filing, since the goods sent for filing may not necessarily be received by the Patent Office (see [0028]).

In Kanebo, there is much reiteration of the problems with prior art trademark applications, and this serves to support the inventiveness of the present application, in that finding a solution to these well-documented problems proves to be elusive. See, for example, [0004] Kanebo and the last sentence of [0003].

Kanebo appears to be concerned with scanning in trademark applications, see, for example, the image scanner, image input means and image storage units 12, 14 and 15 in Figure 3 of Kanebo. Particularly, Kanebo is concerned primarily with scanning in a

list of goods and services of a trademark application. Kanebo is not an on-line filing system, but rather relies upon scanning in text, and then cross-checking the text against a stored list of goods and services. Use of the Kanebo system requires a scanner, and, therefore, that system introduces extra complexity and operations required by the user (i.e., scanning in a list of goods and services).

In contrast, the present application does not require scanning in a list of goods and services, but rather the goods and services can be selected from a drop-down menu presented by the system to the user, and the user can select individual goods/services from the predetermined list which is presented to the user.

Kanebo does not allow selection of individual goods/services from a predetermined list presented to a user. Kanebo is not fully electronic all the way to the Trademark Office, but relies on a paper (printed) link. In contrast, the present disclosure herein relates to an internet-based electronic commerce system (see [0008] present application as published) to achieve the desired result.

The skilled person would not seek to combine the teaching of Kanebo with TEAS since Kanebo is primarily concerned with scanning in trademark images and in generating a printed trademark application, not with on-line filing of trademark applications. The problem set out in Kanebo is in printing out a form, where the spaces on the form and the number of pages are not large enough to include a specification of goods and services. In any case, a combination of Kanebo and TEAS does not arrive at the claimed features of the present application.

3.b.i. The machine-generated English translation of Kanebo is difficult to understand. However, with respect to point 3.b.i., “presenting a set of class headings

for said list of goods/services," the text referred to in Kanebo at page 5 [0011] does not disclose "presenting a set of class headings for said list of goods/services." Rather, Kanebo discloses at that passage, "searching relational database 10 for corresponding goods/services," the search being based upon a receipt number. Consequently, Kanebo does not disclose "said means for presenting said predetermined list being capable of, presenting a set of class headings for said list of goods/services."

3.b.ii. Concerning the feature cited in 3.b.ii., "presenting said list of goods/services as a set of predetermined words describing individual goods/services," the Examiner refers to page 5 of Kanebo [0012]. However, the text referred to in Kanebo does not disclose the claimed feature. All that is disclosed in Kanebo is a "trademark registration application application listing device."

3.b.iii. Concerning objection 3.b.iii., "means for selecting individual goods/services from said predetermined list, said means for selecting individual goods/services being capable of. . ." The Examiner cites Kanebo, page 1, the feature being "a specified commodity/work correspondence relation input means 5 for inputting correspondence between a specified commodity and work." This does not disclose "means for selecting individual said goods/services from said predetermined list.

3.b.iv. Concerning objection 3.b.iv. directed at the feature of "selecting a class heading of goods/services, in which case a said selection corresponds to all goods/services stored in a predetermined list," the Examiner points to Kanebo, page 1, the feature of "a specified commodity/work correspondence relation input means 5 for inputting correspondence between a specified commodity and work." The feature

referred to by the Examiner is not the same as the feature claimed, and there is no prior disclosure of the feature claimed in Kanebo.

3.b.v. Concerning objection 3.b.v., the feature “editing said predetermined list of goods-services by accepting modification of said set of predetermined words,” the Examiner points to Kanebo, page 1, “. . . extracting its corresponding sought, specified commodity and work and outputting the extracted contents from a printer device and application.” In the passage referred to in Kanebo, there is no disclosure of accepting modification of a set of predetermined words, and no disclosure of editing. The passage cited in Kanebo bears no relationship to and does not anticipate “editing said predetermined list of goods/services by accepting modification of said set of predetermined words.” The passage referred to in Kanebo simply extracts data for printing. It is not editing or modifying the data.

3.b.vi. Concerning the Examiner’s objection 3.b.vi., as correctly pointed out by the Examiner, Kanebo does not explicitly disclose an internet-based system. Rather, referring to the passage at Kanebo, page 1, “outputting the extracted contents from a printer device 8 as an application,” the Kanebo system appears to be a paper-based system, which prints out a form which is then posted to the Patent Office as a trademark application. Consequently, all the interactivity issues and problems involved in real time on-line systems are not present and are not addressed by Kanebo. Kanebo does not solve the problems addressed by the present application.

## **TEAS**

TEAS does not disclose:

means for presenting a predetermined list of goods/services. . .said means. . .being capable of :presenting a class of said heading to said goods/services; and presenting said list of goods/services as a set predetermined words described individual said goods/services.

Rather, in the TEAS disclosure at the form part section 1(a) and 1(b), the user has to input a list of goods and services and the class number, rather than being presented with the goods/services and the class number by the system.

4. and 5. With respect to claims 34-38, 40-46, 50-52, and 56-57, Kanebo does not explicitly expose the features referred to in paragraph 5 of the Office action. Since these features appear in the corresponding dependent claims, then amendment of the respective independent claims to effect novelty and inventive step renders the dependent claims also novel and inventive.

6. The independent claim to which claim 47 is dependent has been amended so as to be novel and involve an inventive step. Claim 47 derives novelty and inventive step by virtue of dependency on its independent claim.

8. The independent claims to which claims 48, 53 and 58 are dependent have been amended so as to be novel and involve an inventive step. The dependent claims derive novelty and inventive step by virtue of dependency on their respective independent claims.

10. With respect to claims 60-62, the independent claims have been amended so that all corresponding dependent claims derive novelty and inventive step by virtue of dependency on an independent claim.

**CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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